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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,329	02/13/2001	Koji Fukumoto	826.1675/JDH	9064
21171	7590	06/22/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			NASH, LASHANYA RENEE	
			ART UNIT	PAPER NUMBER
			2153	3

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,329

Applicant(s)

FUKUMOTO ET AL.

Examiner

LaShanya R Nash

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-8 are pending.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

Claims 6 –7 are objected to because of minor informalities. In lines 3 and 4, of claims 6 and 7 respectively, “emphasizing” is duplicated. Examiner suggests replacing one instance of emphasizing with “highlighting” in view of the specifications.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed computer program is considered software per se. Although a program has functionality when employed as part of a computing system, embodied in, “a propagating signal” it lacks tangibility. As a result, the aforementioned computer executable program is non-statutory.

In order to expedite a complete examination of the application the claims rejected under 35 U.S.C. 101 (non-statutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, and 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Kohler (US Patent 6,192,396).

Kohler teaches an electronic messaging system that allows a sender to designate and highlight recipient-specific information, in order to eliminate sending identical messages with portions that may not be pertinent to certain recipients.

In reference to claim 1, Kohler shows that the E-mail system with recipient-specific content system includes:

- A receiving device receiving transmission information transmitted from a sender to a plurality of receivers, **"In operation, a user generates an E-mail message**

using one of the clients... The user then sends the E-mail message to recipients who have access to the E-mail clients of computerized messaging system 1...the message is communicated to E-mail server 6" (column 3, line 63 to column 4, line 1 and Figure 1); and

- An emphasizing device emphasizing and highlighting the transmission information for each receiver, and preparing E-mail information for each receiver, **"The portions of the message itself may also appear colored, underlined or otherwise highlighted...so as to indicate that the highlighted portion has a limited list of recipients...Color coding or some other form of differential highlighting (such as multiple underlining) may also be employed as to show which different portions of a message are sent to different sets of recipients"**(column 2, lines 33-49 and Figure 6);
- A transmitting device transmitting the E-mail information for each receiver, **"The user then sends the E-mail message to recipients who have access to the E-mail clients of computerized messaging system 1..."**(column 3, lines 64-65).

In reference to claim 2, Kohler teaches emphasizing and receiving selected portions of electronic messages intended for specific users via computing devices. As previously discussed, the E-mail client/server computers as disclosed in the Kohler E-mail system support transmitting, receiving, and text emphasizing functions. Thus, the computers

are functionally equivalent to the aforementioned devices. Kohler further shows the E-mail client/server computers as:

- Receiving device that receives a part of the transmission information that the sender designates and information about a corresponding transmission destination, "...**authoring a computerized message that contains recipient-specific content involves...identifying one or more recipients to which at least one portion of the message will be sent, and for each recipient associating at least one portion of the message...**"(column 2, lines 14-19); and
- Emphasizing device that emphasizes and highlights the designated part and prepares E-mail information for a receiver corresponding to the transmission destination, "...**visual cues in message text area 51 and list boxes 47 through 49 preferably are provided to indicate which portions of the message are designated for which recipient...Other types of highlighting and other color schemes can be used to provide the foregoing visual cues...**"(column 7 lines 40-60 and Figure 6), "**E-mail editor generates separate messages corresponding to each subset of identified recipients**"(column 11, lines 30-32).

In reference to claim 4, Kohler teaches a client/server computer terminal apparatus employed in the aforementioned electronic messaging system (column 4, lines 31-54 and Figure 2). The disclosed terminal apparatus comprises:

- A transmitting device transmitting transmission information prepared for a plurality of receivers, **“Network interface 17 provides an interface between computer system 10 and network...Thus, network interface 17 provides computer system 10 with access to computerized messaging system”**(column 4, lines 51-54 and Figure 2); and
- An indication device indicating E-mail information that emphasizes and highlights the transmission information for each receiver, to be sent to each receiver, **“Provided with computer system 10 are...pointing device such as a mouse for pointing and to and for manipulating graphical user interfaces and other objects...”**(column 4, lines 40-44 and Figure 2), **“In order to generate a message, a user manipulates items in an E-mail window using a cursor controlled with pointing device 14...focus indicator follows the cursor, any text through which the focus indicator passes is highlighted”**(column 6, lines 13-30 and Figure 6).

In reference to claims 5 and 8, Kohler discloses that, “computer system 10 also includes a mass storage device such as a fixed disk 15 for storing computer executable process steps for E-mail applications...” (column 4, lines 44-49 and Figure 4). These E-mail applications, specifically the E-mail editor and reader software, provide the various functions of the messaging system (column 5, lines 19-30). As applied to previous claims, functions of the electronic mail system, as shown by Kohler, include: receiving

transmission information from a sender to a plurality of receivers; emphasizing and highlighting the transmission information for each receiver; preparing E-mail information for each receiver; and transmitting the E-mail information for each receiver. Therefore, Kohler teaches a system comprising executable code that specifically implements the previously stated functions. This is equivalent to the software program disclosed by the applicant.

In reference to claim 6, Kohler shows a method comprising:

- Preparing transmission information to be transmitted from a sender to a plurality of receivers, **"E-mail editor is carrying out the foregoing authoring operation... In step S1101, E-mail editor 31 accepts portions of a message (i.e., text/and or attachments) entered by a user...In step S1104 identification of recipients from the list is accepted"**(column 10, lines 53-61 and Figure 11); and
- Emphasizing and highlighting the transmission information for each receiver, **"...flow then proceeds to step S1108, where visual cues are provided indicating the associations between portions of the message and recipients. These visual cues can be in the form of underlining, color schemes, or other forms of highlighting"**(column 11, lines 5-9 and Figure 11);
- Preparing E-mail information for each receiver, **"In step S114, E-mail editor generates separate messages corresponding to each subset of identified recipients"**(column 11, lines 30-32 and Figure 11);

- Transmitting the E-mail information for each receiver, “...**command has been given to send the message...**”(column 11, lines 28-29 and Figure 11);
- Emphasizing and displaying the transmission information for each receiver, “**In steps S1301, E-mail reader 32 displays text and icons for attachments for a message, preferably including visual cues...**”(column 11, lines 62-65 and Figure 13).

In reference to claim 7, Kohler explicitly discloses:

- Receiving means for receiving transmission information transmitted from a sender to a plurality of receivers, transmitting means for transmitting the E-mail information for each receiver, “**Network interface 17 provides computer system 10 with access to computerized messaging system 1**”(column 4, lines 51-54 and Figure 2), “...**user sends the E-mail message to recipients who have access to the E-mail clients of computerized messaging system 1**”(column 3, lines 63-67); and
- Emphasizing means for emphasizing and highlighting the transmission information for each receiver, and preparing e-mail information for each receiver, “**As shown in Fig.3, computer system 10 includes central processing unit (CPU)...main memory (RAM) 21, ...Main memory 21 interfaces with computer bus 20 so as to provide RAM storage to CPU 19 during execution of software applications**”(column 4, line 55 to column 5, line 1 and Figure 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kohler as applied to the claims above, and further in view of Krause et al (US Patent 6,154,757). Kohler shows substantial features of the claimed invention, as previously addressed. However, Kohler does not teach a storing device storing keyword information predetermined for each receiver and subsequently highlighting these keywords included in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Kohler as evidenced by Krause.

In an analogous art, Krause discloses an electronic text reading environment enhancement method and apparatus in which designated words and phrases can be emphasized in an electronic text (column 3, lines 59-63). Specifically, Krause shows a wordlist comprised of various words and phrases for the user (column 7, lines 19-38 and Figure 3). The contents of the wordlist are highlighted within displayed electronic text (column 29, lines 48-52 and Figure 14).

Given this feature a person of ordinary skill in the art at the time of the invention would have readily recognized the advantages of modifying the recipient-specific E-mail

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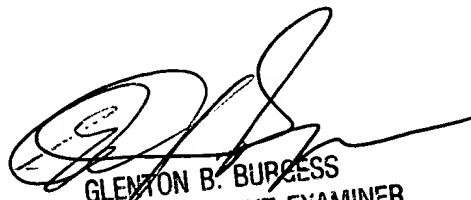
system disclosed by Nelson, in order for the recipient to maximize their speed and comprehension in reading electronic mail content (Krause column 3, lines 24-26).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya Nash whose telephone number is (703) 305-8910. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



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